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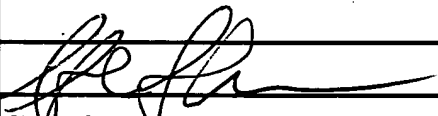
Application Number	10/729,973
Filing Date	12/09/2003
First Named Inventor	William Y. Sun
Art Unit	3739
Examiner Name	Kasztejna, Matthew John
Attorney Docket Number	

### ENCLOSURES (Check all that apply)

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<b>Remarks</b> This is a Response to the Request for Reconsideration and Rehearing mailed 03/20/2008.		

2008 APR -8 AM 10:09  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William Y. Sun

Appeal No. 2007-0692

Serial No.: 10/729,973

Group Art Unit: 3739

Filed: 12/09/2003

Examiner: Kasztejna, Matthew John

For: **TONGUE STABILIZER FOR LARYNGOSCOPE BLADE**

\*\*\*\*\*  
**RESPONSE TO REQUEST FOR RECONSIDERATION  
AND REHEARING**  
\*\*\*\*\*

Commissioner for Patents  
P.O. Box 1450  
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BOARD OF PATENT  
APPEALS & INTERFERENCES  
2007 APR -8 AM 10:09

Honorable Members of the Board of Patent Appeals and Interferences:

Examining Group 3700 (Examining Group) has concluded that the Board of Appeals and Interference (Board) decision of March 8, 2007, in this appeal, was in error when it reversed the examiner's 35 USC 102(b) rejection of claims 1 and 8.

For the reasons previously set forth, and the supplemental reasons addressing the Examining Group's present remarks, your applicant believes that the Board had more than sufficient reasons for the reversal and that the Examining Group's statements in opposition are false, misleading and self-serving as to both the facts and the law.

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## **Group 3700 Examination**

The proper application of the law by the Board of Appeals is greatly appreciated. This, unfortunately, is not the case with examinations in the Patent Office and, in particular, in Group 3700. Anything the Board of Appeals can and is willing to do to get examiner's, their supervisors, and management to do, to follow the law would also be greatly appreciated. The authority and decisions of the Board of Appeals are being overturned, ignored and circumvented, and there seems to be little respect for time constraints, with apparent fraud being conducted, accepting fees but not delivering Examiners Answers, by Examiners and Groups, all at unconscionable, and at times impossible, expense to inventors.

Examiners are overturning Board decisions.

They are harassing inventors to prevent Board decisions.

They are apparently not even reading claims and references, relying on personal opinions and interpretation or impressions and repeatedly entering new grounds of rejection to avoid issuing patents and appellate review.

In this appeal, 2007-0692 (SN10/729,973, filed 12/09/2003) the "Request for Reconsideration" is just another example of how the examiners, supervisors, directors, and even the Commissioner of Patents, refuse to follow the law, even when they are clearly confronted with it by an applicant or the Board citing published decisions by the authorities that extend from those of the Board to the U.S. Supreme Court,

This application is unfortunately representative of the work coming out of Examining Group 3700. There appears to be as much contempt for the Board of Appeals as with the applicants, the law and procedures when they disagree with the examiner. It appears they again, in this Request for Reconsideration, have not even read the Board decision or investigated the issues and law involved.

This application was appealed from the examiners final rejection based on the combined references of Van Dam (U.S. Patent No. 5,065,738, issued November 19, 1991) and Rooney et al (U.S. Patent No. 5,656,014, issued August 12, 1997). When the examiner was informed, in the Appeal Brief to this Board in this application, of the facts as to what the claims and references said, the rejection was dropped in favor of the Panduit article. Even though the Board decision was precisely accurate legally, the Examining Group cannot and will not accept the Board's decisions. It has now been over a year since the Board rendered their decision. This delay is inexcusable and the Examining Group should be blocked from the Reconsideration Request by laches.

The appellate process in Group 3700 has become a farce as to application of the law, proceedings and compact prosecution. There is an attitude of arrogance that permeates the whole patent process there. Your applicant would greatly appreciate it if the Board of Appeals would review the Appellate conduct of Group 3700 since it appears that they have demonstrated complete contempt for both the appeal process and the Authority of the Board of Appeals.

As examples of this:

The Board of Appeals in SN 09/864,198, filed May 25, 2001 reversed a 35 USC 103

rejection based on a reference that the examiner admitted did not show all of the claimed structure. The Board reversed the examiner's rejection with the opportunity to back up his personal opinions with art. The Board decision was, for all practical purposes, ignored and the examiner proceeded to make a 35 USC 102 rejection of the very same claims on the very same reference that both the examiner and Board admitted did not meet the claims. The applicant, for monetary reasons, permitted modification of the claims. The applicant was cheated out of his adjudicated claims.

In Serial No. 10/739,336, filed 12/19/2003, three petitions to the Commissioner were filed. Two were totally ignored until the Board, addressing an Appeal Brief, remanded the case to the Group to have the Petitions answered. The answer to the Petitions was made but then was used as an excuse to enter a new grounds of rejection.

In that same Serial No. 10/739,336, filed 12/19/2003, in complete contempt for "Compact Prosecution" and appellate procedure, the examiner was permitted to make seven (7) new grounds of rejection. Four (4) of these were made after the filing of a First Brief to the Board. This meant that, instead of just the one brief, 5 Briefs were necessitated in this one application at a ridiculous expense to the small entity applicant. These were made with the blessings of the supervisor and Director of Group 3700, who personally signed off on and approved the seventh (7<sup>th</sup>) new grounds of rejection, creating a need for a Fifth (5<sup>th</sup>) Appeal Brief.

In Serial No. 10/687,748, filed 10/20/2003, now under appeal, the examiner has made three (3) different rejections of the claims. All three rejections are new rejections wherein it is

inconceivable that the examiner read the claims and references before receiving a response from the applicant.

There will be no justice or intended patent prosecution for inventors until the examiner can read the claims and references and the Board of Appeals automatically takes jurisdiction of an application once the fees have been paid and a Brief is filed, and procedures enforced with evaluations of Brief contents determined by the Board or a knowledgeable clerk working for the Board, with new grounds of rejection after the filing of a Brief limited to personal written approval by the Group Director.

## Issues in Appeal Reconsideration Request

The Examining Group has called the Board of Appeals to task for their decision that the reference Panduit does not anticipate claims 1 and 8. The “Issues on Appeal” stated on page 2, lines 9 - 12, of “REQUEST FOR RECONSIDERATION AND REHEARING” is an erroneous oversimplification.

The statement, “Panduit ... discloses a plate and all the structural limitations that are expressly recited in claim 1 (a plate having a top surface, a bottom surface, a forward end, a rear end, a first side, a second side and a central area),” is a false and misleading opinion.

As to the statement, on lines 13 - 14, “The issue is whether Panduit’s plate can be considered as a tongue engaging plate,” is not the only issue. The issue is and has been if claim 1 is anticipated under 35 USC 102(b) by Panduit.

### Laches

The Examining Group’s sitting on this application for over a year since the Board’s reversal before asking for reconsideration constitutes *laches*. The entering of new grounds of rejection flies in the face of compact prosecution, and long office delays, in light of the conversion of protection from seventeen years from issue to twenty years from date of filing, are unconscionable. The USPTO is supposed to facilitate the patent process but the Examining Group is trying to destroy it by denying inventors their deserved protection, making bogus rejections that violate common sense, the facts, proper procedures and the application of the law, and with long delays at every step of the patent process. The Board should not entertain an

objection to their decisions beyond a reasonable time period, such as those imposed on patent applicants, and it is thus requested that review of the Request for Reconsideration be denied.

### **Short Version Response**

The Examining Group contends that “engage” is the same as “contact” and that Panduit can make tongue contact. While your appellant does not pretend to speak for the Board, as understood, it appears that the short answer to the primary issues raised by the Examining Group were succinctly addressed by the Court of Appeals for the Federal Circuit in their decision in Renishaw v. Marposs Societa’ Per Azioni, 48 USPQ 2d 1117 (Fed.Cir. Sept 16, 1998). In that decision the court employed the pair of “claims construction canons” (a) one may not read a limitation into a claim from the written description, but (b) one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part. Your appellant assumes this is precisely what the Board accurately did in its determination to reverse the 35 USC 102(b) rejection, the erroneous opinion of the Examining Group not-with-standing.

### **Long, Appropriate Response**

The issue at hand can be expanded on, and your appellant would be derelict and remiss not to address the false and misleading arguments made by the Examining Group.

The Examining Group has requested that the Board apply a narrow-minded view of the issue they address. With all due respect, it would be presumptuous to believe the decision of the

Board in the first place was made blindly insofar as one isolated claim issue is concerned. The issues are not limited to the single claim limitation of a tongue support plate being a structure that is anticipated, or is not anticipated, by what the Examining Group apparently considers the flat top surface of Panduit to be.

The proper issue is if claim 1 is anticipated by the wire securing tie mount of Panduit. Any ignoring of the totality of claim 1 or the total showing of Panduit is in error. While the Board centered its decision on the tongue supporting plate, it certainly is not believed they put on blinders to arrive at their decision by concentrating solely on the tongue engaging plate.

The issue may in part turn on the interpretation of the claimed phrase "tongue-engaging plate," but the 35 USC 102(b) rejection involves the total claim, and the claim is to a combination of elements apparently ignored by the Examining Group.

The totality of the invention, from the title of the invention, "Tongue Stabilizer for Laryngoscope Blade" to the preamble of the claims, always addresses the structure and function of stabilizing the tongue. There is a difference between having a surface capable of "contacting" a tongue and one "engaging" a tongue. There are few surfaces that could not be contacted by a tongue by simply sticking the tongue out. Such is not properly in issue.

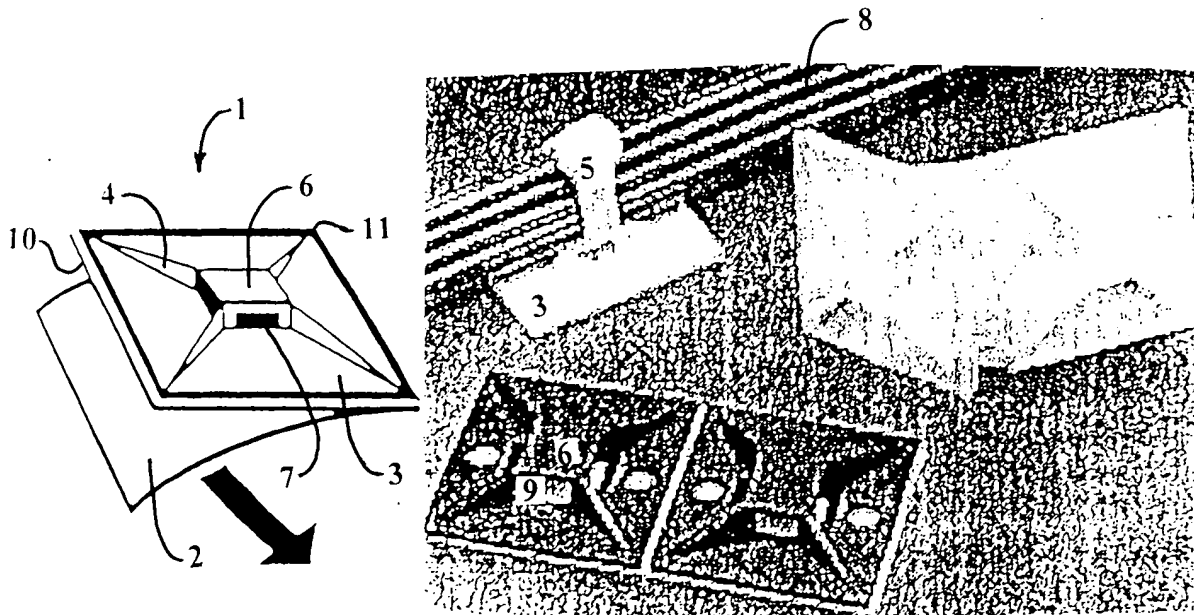
**Claim 1 Recites In Pertinent Part:**

Claim 1 is drawn to a combination. (A) The preamble states that the invention is to "a

tongue stabilizer for a laryngoscope blade comprising: “; (B) “a tongue-engaging plate having a top surface, a bottom surface and a central area ... ; (C) a foam strip support having a top surface and a bottom surface with said foam top surface attached to said tongue engaging plate bottom surface... “ and (D) “ a pressure-sensitive adhesive having a top surface attached to and extending along said foam support bottom surface ... available for attaching said tongue stabilizer to a laryngoscope blade.”

#### **Panduit Shows:**

The article 1 of Panduit has a base plate 3 with upstanding posts or ribs 4 that support what the Examining Group evidently referred to as a “plate” 6. The examiner may have the option of calling the top surface the plate or the base the plate. They are not the same element and do not perform the same function in the combination. The plate functions to support cables



or wires 8 that are held in place by a strap 5 that extends through a slot 7 between the plate 6 and base 3 over an opening 9 in the base that are separated by the posts or ribs 4 that extend

between the base and plate. The only things attached to the plate 6 bottom are the posts 4. The posts extend to the sharp corner edges 11 of the base and together the posts and “plate” preclude the tongue, or any such object, from contacting the base. An adhesive 2 coated foam 10 can be attached to the bottom of the base to secure it to a surface.

## **Reconsideration**

The Examining Group is attacking the Board for doing precisely what the courts, including the Court of Appeals for the Federal Circuit and the U.S. Supreme Court have instructed them to do. The Board has properly interpreted the structural recitation by following the simple procedure for doing so in the patent law, believed to be in use for a century, whether the Examination Group wants to accept it or not. The Examination Group’s complaint, that the Board decision violates the ordinary and customary meaning and patent law, is pure “poppy-cock.”

First, the Board decision is in conformance with the simple dictionary definitions of the involved words.

Second, the Board decision complies with the requirement that the trier of the facts look to the specification if there is any confusion as to the meaning of a term.

Third, the Examining Group argument does not find support in reality, smell, or common-sense and Panduit would be inoperative alone or if placed on a laryngoscope blade.

Fourth, the Examining Group’s attack on the Board decision’s wording relating to an ordinary and customary interpretation by a mechanic in the art, is based on an erroneous, personal opinion that is not supported by the facts or evidence of record.

Fifth, the structure of Panduit does not anticipate the combination of elements as they are claimed.

### **1) Dictionary Definitions**

The absurdity of the Group's argument begins with *Webster's Dictionary* definitions. "Contact" is a state of "touching" or "meeting" and "engaging" is "to grip" or "fit into" or "mesh" or "interlock." This alone should have precluded the use of Panduit as a 35 USC 102(b) rejection reference.

To challenge the Board decision the Examining Group has first erroneously equated "engaging" to broadly be merely "contacting" and then erroneously concluded that since Panduit can be made to contact a tongue it thus anticipates the structure "tongue-engaging plate."

It is your appellant's contention that the Board should never have needed to go to the specification, but in doing so they were merely following the law that is clear and unambiguous for resolving doubts. There is a clear difference between reading non-existent limitations into a claim and interpreting limitations already there, as clearly set forth in the law but ignored by the Examining Group, when they mentally changed the words of a claim, or substituted one word for another, and then gave the broadest possible interpretation to that non-existent word improperly placed in the claim. The violation of the law is reading limitations out of the claims as is now being attempted by the Examining Group:

The Board statement that engaging includes “comes into contact with” (Page 4 lines 12 - 16) is accurate, but to limit “engaging” to “contacting” requires a modification of the claim and denies the fact that “engaging” is not restricted to “contacting” by even the simple dictionary definition.

Much of nothing has been made of the Primos v. Hunter decision, 70 USPQ 2d 1129 (CAFC 2006), addressing “engaging.” The holding in that case that “engaging” and “contact” were essentially the same is totally irrelevant in this case. The word “engaging” was used in the same claim with “sealing” and “interlocking.” The court held that to interpret engaging to take the same meaning as sealing or interlocking would improperly exclude its use disclosed in the specification and in particular the drawing figure. More specifically, the Court appropriately looked to the specification to interpret the definition of engaging as used by the applicant in that case.

Not only is a dictionary definition of minor pertinence, in this instance it supports and conforms to the specification and serves as a confirmation that the Board accurately evaluated the claim. Even if the terms in dispute were both defined to be broader than that disclosed in the specification, as they are erroneously alleged to be by the Examining Group, a broader dictionary meaning than that disclosed in the application would be of no consequence as the disclosure would control. Multiform Desiccants v. Madzam, 45 USPQ 2d 1929 (FedCir Jan.15, 1998).

## 2) Resolving Doubts by Specification Description

The very fact that the Examining Group chooses to object to the Board's determination that "tongue engaging" is narrower than interpreted justifies the Board's going to the specification. As stated by the Board, the specification discusses the various structures for "engaging" and while specific structures may not be read into the claims, the basic concept or meaning of the words can. To carry the Examining Group theory one short step further would permit generic claims or claims that broadly recite structures, not found in the prior art, to be rejected by a non-analogous reference simply by defining or redefining word meanings.

The same conclusion reached in Renishaw v. Marposs ... (supra) was reached by the Court in Elekta Instrument v O.U.R. Scientific, 54 USPQ 2d 1910 (Fed. Cir. June 1, 2000) and Hill-Rom v. Kinetic Concepts, 54 USPQ 2d 1437 (Fed.Cir. April 14, 2000).

Further, the issue was addressed decades ago by the U.S. Supreme Court in U.S. v. Adams, 148 USPQ 479 (USSC 1966) where the court stated that the specification and drawings must be looked to in order to properly grasp the invention or explain any ambiguity in the claims and it is permissible to examine the specification to understand properly the scope of a patent claim.

The Board is believed to have simply complied with the law even if the Examining Group refuses to do so or refuses to accept the Board's decision.

### **3) Examining Group's Illogical Conclusions**

The use of Panduit as a reference requires not only defining the plate 6 to be able to “contact” and “engage” the tongue, it inherently involves the base 3. Before the plate can contact the tongue, the base must also be accommodated. In simplified terms, the tongue is attached at the lower rear of the mouth and fits into the lower mouth between the teeth. The article of Panduit discloses a small elevated or raised section, plate 6, on a very large base 3. The large base 3 has sharp corners 11 on relatively sharp edges that extend outwardly from the small plate 6 in all directions the width or more of the plate. The problem being addressed is to confine or control the tongue so that, by use of a laryngoscope, a tube can be inserted without doing damage to, or being blocked by, the tongue. . Even if the plate 6 of Panduit could contact the tongue, the base 3 would tend to both do damage to the tongue or mouth flesh and to block anything being inserted past the tongue.

The Panduit reference is not just a flat plate 6, it is a combination of elements that together perform a specific function. The Examining Group insists that the “tongue engaging plate” per se is anticipated by Panduit. Just imagine going into a hospital with a breathing problem and the respiration therapist attempts to shove the tie mount of Panduit into your mouth telling you that the flat platform is to hold your tongue in place as he shoves a tube down your throat. A probable question would be “and what does the base plate 3 do, sticking out in all directions with sharp corners in close proximity to the top plate 6, when you put the flat plate in my mouth and how do you maneuver the base plate to get the flat plate to hold my tongue and, if the flat plate is in contact with my tongue, where is the base plate” since having the “plate” 6 on

top of the tongue would cause the base plate to actually block intubation and anything else it was attached to?"

The only rational way the plate 6 of Panduit could contact the tongue of a patient would be to have it placed in the mouth with the plate facing down as the tongue surface faced up, or to have the tongue stick out. The Board accurately drew a distinction between this simple contact and "engaging" as clearly disclosed in the specification where the shape and purpose are clearly set forth.

The use of the "flat plate" 6 of Panduit as a "tongue engaging plate" does not pass the common sense test, as addressed by the Supreme Court in KSR International v. Teleflex, 82 USPQ 2d 1385 (USSC 2007). It appears that the 35 USC 102(b) rejection based on Panduit, and in particular the use of the plate 6 of Panduit, as a tongue engaging plate is totally lacking in common sense. It is a requirement that an element must be placed so as to serve the intended purpose, as addressed in Pall Corp.v. Hemasure, 50 USPQ 2d 1947 (Fed.Cir. 6/8/1999).

As stated in Milliken Research v. Beaunit, 182 USPQ 421 (DCWDNC 1974) a prior art reference must be read as a whole to rely on its teachings under 35 USC 102 or 103. If the reference is indefinite it cannot anticipate or be modified to anticipate.

If the Panduit mount were placed on a laryngoscope blade and placed inside a mouth so as to “contact” the tongue, neither the laryngoscope blade or plate would be capable of performing their intended function.

Not only has the Examining Group modified the article of Panduit to anticipate the claim, there is a serious doubt that the extensive base 3 of Panduit with the elevated plate 6 on the ribs 4 would permit the plate to engage a tongue for insertion of a tube. Because of the extent and position, the base would restrict, if not prevent, the plate 6 from contact with a tongue as the first problem would be getting the base in the mouth and the second problem would be manipulating the base when in the mouth so that the plate could contact the tongue, whether the Panduit articles were attached to a laryngoscope blade or not.

#### **4) Personal Opinions are not Facts**

The Examining Group has concluded Panduit anticipates the claims. Several allegations are made, but no proofs are provided. When reaching their conclusion that more than a flat raised surface was required to meet the limitations, the Board properly referred to the specification and quoted page and line as justification. The Examining Group has offered no proof as to what the mind set of the mechanic in the art reading “engaging” would conjure up. It is believed that their conclusion is false and misleading personal, self-serving opinions rather than evidence that proves the Board’s decision was in error. It is difficult to believe that any competent examiner or Examining Group would, examining an application, accept such a bald assertion as proof that they had made an error. At the least, an affidavit would be required by a

person competent to make such an allegation. In this case it would be necessary to show that everything, from the simple dictionary distinction to the detailed specification disclosure, was erroneous. The allegation that the Board has violated the ordinary and customary meaning of the words or terms claimed is ridiculous and no proof or evidence of record has been made to show otherwise. The only evidence of record is that the Examining Group does not understand the issues being argued or the law.

There is no justification for the Examining Group's "conclusion" that the reference to Panduit anticipates the claims. The rejection is based on probabilities and possibilities, as pointed out on pages 13 and 14 of the Amended Appeal Brief, filed 3/09/2006, under title "The Publication is Indefinite" and "The Publication has an Insufficient Disclosure." In view of the indefinite disclosure and structural differences pointed out above, it is obvious the rejection relies on erroneous personal opinions that the reference inherently anticipates the claims.

The use of personal opinions was likewise addressed in the Amended Appeal Brief on page 20 under title, "The Examiner's Personal Opinions are not a Valid Substitute for Facts and Evidence," with case cites included there.

Before something can be considered to be inherently the same as the claimed structure there must be proof. Anticipation requires proof and the mere probability is insufficient, A.B. Dick Co. V. Simplicator Corp., 2 USPQ 428 (CCPA 1929). To prove "inherence" there

must be something more than probabilities or possibilities, Forward Process Co. v. Coe, 116 F.2d 947.

Rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed and described in the prior art. Even an accidental or unwitting duplication of an invention cannot constitute an anticipation under 35 USC 102, In re Marshall 198 USPQ 345 (CCPA 1978). An accidental or unwitting duplication of an invention cannot constitute an anticipation, In re Felton, 179 USPQ 295 (CCPA 1973), following the Supreme Court holding in Tilgman v. Procter, 102 U.S. 707 (USSC 1880); Eibel Process Company v. Minnesota and Ontario Paper Co., 261 U.S. 45 (USSC 1923).

While the inventor may be his own lexicographer, as addressed on page 6, lines 1 - 8 of the Request for Reconsideration, that privilege does not extend to the examiner or Examining Group to redefine a claim limitation for rejection purposes. Your appellant finds no structural claiming of a flat plate and the Examining Group has no justification for reading it into the claim or changing the claim to avoid a proper 35 USC 102(b) reversal. To even imply that the claim terms need a specific description, beyond that in the specification, is ludicrous, given the prosecution history of this application.

Neither the Examining Group nor the Board, at the request of the Examining Group, has the authority to change the claim limitations so that they read on a non-analogous reference.

It is so absurd to say that claim 3 does not further limit claim 1 that it will not be addressed.

Claim 3 is not properly in issue (page 6 lines 9 - 12).

Even with expert testimony, which is noticeably absent in this application, the Examining Group's allegations would fail since, while expert testimony may be used to clarify the patented technology, it cannot be used to correct errors, erase limitations, or otherwise diverge from the description contained in the specification. Aqua-Aerobic Systems v. Aerators, 54 USPQ 2d 1566 (FedCir May 3, 2000); See also, Upjohn Co. V. Mova, 56 USPQ 2d 1286 (FedCir Sept 11, 2000) and Dow Chemical v. U.S., 56 USPQ 2d 1014 (FedCir Sept. 6, 2000).

It is the Examining Group that has the burden of showing that the specification and claims do not mean what they clearly mean. The Examining Group cites are irrelevant as the issues they address are not pertinent to the issues that are properly under consideration.

#### **5) Structure Combination Claimed Not Anticipated**

As stated almost a half century ago by the CCPA, only truly broad claims can literally read on unrelated art, In re Tibbals, 137 USPQ 565 (CCPA 1963). A close review of the "alleged anticipating" reference reveals the accuracy of this truth and explains why the examiner has not provided the element for element comparison necessary for a proper 35 USC 102(b) rejection.

The Examining Group has stated, and insists that, claim 1 is anticipated by Panduit. The claim can be anticipated by Panduit only by misinterpreting the claim language, ignoring the

claim structure, and using a big imagination when interpreting Panduit. The Examining Group has attacked the Board's conclusion, "The skilled worker would not have reasonably interpreted the tongue-engaging plate so broadly that it would cover the TWO-TIERED cable mount surface described by Panduit ... there is nothing about its upper surfaces that would reasonably suggest it could be used to hold the tongue." (Request for Reconsideration, page 3, lines 14 - 19). The claim has two structure recitations within its body that directly relate to the preamble. Both the "tongue engaging plate" and the "TWO-TIER" structure preclude a 35 USC 102 rejection based on the non-analogous reference to Panduit.

#### **Element Identification**

Claim 1 does not even come close to being anticipated by Panduit. There is no justification for taking a reference, such as Panduit, drawn to a disclosure for advertisement for a wire or cable mount, glancing at it, and mentally concluding that the claim is broad and thus Panduit anticipates it, as appears to be the policy in the Examining Group. The examiner is obligated to read the claim and clearly state where each and every element claimed finds antecedent in the supposedly anticipatory reference. A 35 USC 102(b) rejection cannot properly be made by ignoring claimed structure.

The prior art does not address applicant's problem, does not solve applicant's problem, and does not teach or suggest applicant's solution to the problem, so it does not meet the required strict "every element" and "every function" 35 USC 102(b) requirement. Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co. Et al, 221 USPQ 481 (CAFC 1984).

Although requested, the Examiner has never properly identified the elements of the reference that correspond to the claimed elements, as required by In re Mullins, Wetherby and Chevalier, 179 USPQ 97 (CCPA 1973). The reason for this is obvious, it cannot be done without modifying the reference and injecting personal opinions as to what Panduit teaches or shows.

### **Tongue-Engaging Plate**

The Board has clearly acknowledged that the recitation “tongue-engaging plate,” is structure, as clearly set forth in the specification and intended by your appellant. It has likewise clearly been recognized by both the Board and the Examining Group that “available for attaching said tongue stabilizer to a laryngoscope blade” is a part of the claim, be it an intended use or functional statement of intended use. Note the Examining Group’s Request for Reconsideration (page 3, lines 1 - 13 and page 5, lines 1 - 5).

The primary issue addressed is the structure, “a tongue-engaging plate.” a short one-element phrase taken out of context as a pivotal point in the Board’s decision. The preamble recites, “A tongue stabilizer ... comprising.” While the preamble alone may be only an intended use, the prior art must meet the structural limitations to be inherently capable of performing the intended use. In re Self, 213 USPQ 1 (CCPA 1982). In Pitney Bowes v. Hewlett-Packard, 51 USPQ 2d 1161 (FedCir June 23 1999), the court held that, “when the preamble is not merely a statement describing the invention’s intended field of use but instead is intimately meshed with the ensuing language in the claim, the preamble becomes an integral part of the claim. A term must be read to correspond to the only plausible meaning in context with the written description.

The Board, Examining Group and the appellant now apparently all agree that “tongue-engaging plate” is structure in the claim that directly involves the preamble, “a tongue stabilizer.” Since it is unanimous that the preamble finds structural support in the body of the claim, in both structure and functional use, available for attaching said tongue stabilizer to a laryngoscope blade, the 35 USC 102 rejection fails because this places the applicable law under the legal claim interpretation exemplified by the decision in Pitney Bowes v. Hewlett-Packard.

Only the top surface (plate 6) of the Panduit combination is capable of contacting the tongue. It was held that a claim element must be placed so as to serve the intended purpose. Before a claim can be anticipated by the prior art, the claimed invention must be capable of the same use. Panduit’s mount does not perform this use. The claims must “read on” the prior art. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CAFC 1983).

## **TWO-TIER Structure**

The Examining Group (page 6, lines 13 - 20) addresses the Board’s TWO-TIERED cable mount” remarks and states, “However claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function,” citing In re Schreiber, 44 USPQ 2d 1429 (CAFC 1997). The statement, “Panduit ... nevertheless ... discloses all the structural limitations recited in claim1,” is false and the fact that it is false in and of itself precludes a valid 35 USC 102(b) rejection. The clear statement by the Board is that the cable mount of Panduit is ”TWO TIERED.” This is an independent but critical point the Examining Group has again chosen to

ignore with good reason. This significant but subtle structure conclusively precludes a valid 35 USC 102(b) rejection in view of the claimed elements' locations.

A close review of the showing of Panduit reveals why the requirement to match up element for element for a proper 35 USC 102(b) rejection has been avoided, even though it was clearly requested and the examiner is legally obligated to do so. Panduit does not teach either the claimed structure or problem or use. The mount 1 of Panduit is a support for securing wires using a band or strap 5. An adhesive 2 held base 3 has upwardly extending posts or ribs 4 that support a plate 6. The plate 6 extends above an opening 9 in the base to provide a slot 7 to accommodate the strap 5 that engages and holds the wires 8 in place over the "plate" 6.

The Examining Group has admitted the obvious, that the mount of Panduit is non-analogous art that addresses an entirely different problem from that being addressed by the claims (Request for Reconsideration page 6, lines 17 - 19). From the comments made by both the Board and Examining Group, and agreed to by your appellant, the plate in issue is the raised member 6 of Panduit. This involves the structure and concepts your appellant attempted to explain previously (Amended Appeal Brief, pages 15 - 17). The raised plate 6 of Panduit may be interpreted to contact the tongue; however, when this two-tier structure is acknowledged, with the plate 6 over the base 3 on ribs 4 separated by opening 7, the plate no longer reads on the claim 1 structure that requires the plate base to have the foam strip attached to it. There can be no proper 35 USC 102 rejection as the foam strip of Panduit is not on the "plate" bottom surface, it is on a base 3 bottom surface, physically separated a distance 7 that extends between the plate

bottom and base top surface, that enables a strap 5 to pass between the plate and base. Attention is directed to page 16, lines 10 and 11 of the Request for Reconsideration. Viewed in another way, the claim requires that a foam strip 10 top surface engage the plate bottom surface. The only thing the “plate” bottom surface of Panduit engages is the strap 5 that extends between the “plate” bottom surface and the base top surface. Under either interpretation, the article of Panduit does not anticipate the claims. The reference modification is not proper, In re Randal et al, 165 USPQ 586 (CCPA 1979); Milliken Research v. Beaunit, 182 USPQ 421 (DCWDNC 1974).

Not only does the mount of Panduit not teach a tongue stabilizer or a “tongue-engaging plate,” it does not show the top of a foam strip attached to a tongue engaging plate bottom surface as claimed. This structure is clearly a part of claim 1 and is clearly absent from Panduit and clearly precludes a valid 35 USC 102(b) anticipation rejection.

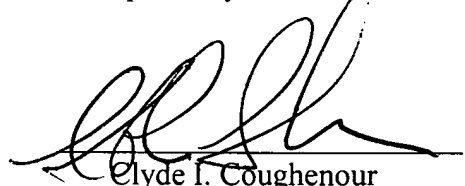
The Examining Group has concluded that Panduit is to a non-analogous art (page 6, lines 17 - 19). Merely admitting that the reference is from non-analogous art does not overcome the totality of the claim language. The recitation of “a tongue engaging plate” and “for attaching said tongue stabilizer to a laryngoscope blade” goes well beyond a mere recitation of intended use. The difference between intended use and function has been ignored. The “available for attaching” to a laryngoscope blade is function, the tongue engaging plate is structure. The preamble, coupled with these recitations alone, makes the claimed subject matter art specific.

## CONCLUSION

Your appellant is of the "opinion" that the only way the 35 USC 102(b) rejection can be sustained would be to ignore the law, the structural difference between the references and claims and common sense. The rejection is based on speculation and imagination, not the facts of record. It is respectfully requested that the 35 USC 102(b) rejection reversal be repeated and expanded to include:

- 1) The Panduit reference does not meet the claim structure "tongue-engaging plate."
- 2) The Panduit reference does not meet the claim structure of a tongue-engaging plate that has a foam support strip top surface attached to its bottom surface.
- 3) The Panduit reference is a non-analogous art that does not meet the requirement of a "tongue stabilizer" with a tongue-engaging plate and a foam support strip on it for attachment to a laryngoscope blade.

Respectfully submitted



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